

OA Item #1: Rejection of claims 36-41 under 35 USC § 251 – Diligence in Filing:

The examiner has rejected claims 36-41 as “being broadened in a reissue application filed outside the two year statutory period”. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant’s application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

“No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”.

Therefore, in order to satisfy 35 USC § 251 fourth paragraph, an applicant must file his application within two years of the issue date of the “original” patent. Applicant respectfully points out that Applicant’s current application is a reissue application of US patent 5,908,057 which issued on June 1, 1999. Applicant’s reissue application was filed on May 29, 2001. Inasmuch as May 29, 2001 is less than two years after June 1, 1999, Applicant’s respectfully asserts that Applicant’s reissue application complies with the requirements of 35 USC § 251 for a broadening reissue application.

In his rejection, the examiner has cited an earlier patent (US 5,832,969) that is one of several included in the chain of pendency of the “genealogy” of Applicant’s current application. Accordingly, Applicant assumes that the examiner’s interpretation of the word “original” differs from that of Applicant’s interpretation. Applicant suggests that absent a law or statute providing interpretation otherwise, that the word original must be given it’s normal meaning which in this case would be the original patent that the reissue seeks to correct. Accordingly Applicant respectfully submits that the Office Action rejection is an improper application of 35 USC § 251.

More specifically, the rejection appears to hinge on the interpretation of the term “original patent” in 35 USC 251. The Office Action appears to interpret the term “original patent” as referring to the *parent* of the patent on which a reissue has been applied. However, the remaining text of 35 USC 251 makes clear that the term “original patent” refers only to the patent on which a reissue application has been filed.

35 USC § 251 begins by stating that “any patent” is subject to reissue if it is defective, provided that “such patent” is surrendered when the reissue patent is granted. The statute then uses the terms “original patent” and “new and amended application” to distinguish between the patent on which the reissue is being sought (the “original patent”) from the reissue application filed on that original patent (“the new and amended application”). Thus, the term “original patent” is not being used to refer to a parent application or any other related application, but rather to the very patent on which a reissue has been filed. In the present application, a reissue application was filed on US 5,908,057, issued from 09/021,617. As such, the “original patent” for purposes of 35 USC § 251 is US 5,908,057. As explained above, as the present application was filed within two years of the grant of US 5,908,057, the present application satisfies the two year statutory requirement.

Applicant further notes that the use of the term “original patent” was used as far back as the 1928 version of the Patent Act, which was long before continuation practice was codified in the 1952 Patent Act. Thus, it seems highly unlikely that the term “original patent” was used in the reissue statute as far back as 1928 to distinguish from a continuation patent when such continuation patents were not yet authorized by statute (although were permissible in common law).

Applicant has been unable to find any other application of 35 USC § 251 that is consistent with the application of 35 USC § 251 present in the Office Action. To the contrary, the interpretation of 35 USC § 251 advocated in the Office Action is contrary to District Court interpretations of the term “original patent,” the Board of Patent Appeals and Interferences use of the term “original patent,” the actions of the Federal Circuit, and the actions of numerous other examiners at the PTO.

A. District Court

In *United States Filter Corporation et. al. v. Ionics Corporation*, a Federal District Court in 68 F.Supp2d 48 (copy of entire case enclosed) interpreted the term “original patent” as that

term is used in 35 USC § 251. There, the Court interpreted “original patent” to refer to the patent on which a reissue application was filed – similar to the present application where the original patent is US 5,908,057. The case deals with the issue of the defendant asserting that the patentee was trying to recapture something given up in prosecution in the parent application as opposed to the patent from which the reissue was filed. In this case, the court stated that “original” is the patent from which the reissue was filed, not the parent patent. Specifically, on page twenty of the ruling, the court stated that “... no good reason exists to interpret the word "original" in the § 251 of the Patent Act to mean anything other than its common-sense meaning; the "original" patent is the patent that is corrected by the reissue patent”. The court went on to explain that in analyzing the reissue patent, the court need only look to the “original” patent, the patent that was corrected by reissue, and not to any of the other patents in the reissue patent’s “family tree”.

B. Similarly Situated Patents

A cursory search of the USPTO database has uncovered a number of instances in which a Reissue application was granted, where the reissue was filed on a continuation patent within two years of the grant of the continuation patent but outside of two years of the grant of the parent patent. See for instance:

- RE38,180, filed Jul. 15, 2003
 - Reissue of US 6,027,201, issued Feb. 22, 2000, which is a continuation of
 - US 5,877,787, issued March 2, 1999.
- RE37,996, filed Apr. 6, 2000
 - Reissue of US 5,736,300, issued Apr. 7, 1998, which is a continuation of
 - US 5,578,422, issued Nov. 26, 1996.
- RE37,858, filed Jun. 11, 1998
 - Reissue of US 5,600,737, issued Feb. 4, 1997, which is a continuation of
 - US 5,428,693, issued Jan. 27, 1995.
- RE37,790, filed May 20, 1999
 - Reissue of US 5,631,612, issued May 20, 1997, which is a continuation of
 - US 5,559,481, issued Sept. 24, 1996.

- RE33,557, filed Jun. 8, 1990
 - Reissue of US 4,783,127, issued Nov. 8, 1988, which is a continuation of
 - US 4,664,453, issued May 12, 1987.
- RE36,540, filed Feb. 13, 1998
 - Reissue of US 5,490,891, issued Feb. 13, 1996, which is a continuation of
 - US 5,397,857, issued March 14, 1995.
- RE38,345, filed Jan. 13, 2000
 - Reissue of US 5,708,235, filed Jan. 13, 1998, which is a continuation of
 - US 5,557,071, issued Sept. 17, 1996.
- RE36,636, filed Dec. 31, 1992
 - Reissue of US 4,981,095, which is a continuation of
 - US 4,901,661, issued Feb. 20, 1990.

[The application leading to RE36,636 described above was before the PTO Board of Patent Appeals and Interferences is described in the unpublished opinion EX PARTE LILLIAN P. STURM AND KURT D. SALOMAN, 1997 WL 1935112. The Board noted that two of the reissue claims were broadened version of claims in the parent application (which was issued more than two years before the filing of the reissue application). The Board did not reject those claims as being filed outside of the statutory two-year timeframe for broadening reissues. Instead, the Board rejected those claims for double-patenting, a rejection which was subsequently cured with a terminal disclaimer. In addition, when referring to the *original patent* claims of the reissue application, the Board used that term to refer to claims from the continuation patent on which the reissue application was filed, not the parent application. Id. at 2.]

C. Federal Circuit

In *In Re Doyle*, 293 F.3d 1355, 63 USPQ.2d 1161 (2002), the Federal Circuit addressed an instance in which a broadening reissue application was filed within two years of issuance of a divisional patent, yet outside of two years of issuance of the parent of the divisional patent. While the case focuses on the applicability of an *Orita*-type rejection, at no time was a rejection

made that the reissue application was filed outside of the two-year statutory timeframe. This was true despite the fact that the Examiner clearly recognized the close relationship of the reissue claims and the parent patent claims -- one of the grounds on which the Examiner rejected the reissue claims was based on an obviousness-type double patenting rejection over the claims of the parent patent. *Id.* at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In *Doyle*, the Federal Circuit ultimately rejected the pending Orita-type rejection and remanded for further proceedings consistent with the opinion.


Conclusion:

Thus Applicant respectfully points out that there have been numerous instances in which patents have been granted on reissue applications on continuation or divisional patents, despite the fact that the parent of those patents had issued more than two years prior to the reissue application. Accordingly Applicant respectfully submits that because the present reissue application was properly filed on US 5,908,057 within the permissible two-year statutory window, that the present rejection be withdrawn. Applicant submits that the arguments presented herein have placed the claims in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: August 13, 2004

Respectfully submitted,


Michael R. Schramm